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| EXAMINER |
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NGUYEN, HAI V

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| ART UNIT | PAPER NUMBER |
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2142

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/02/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/983,041

Applicant(s)

SHIBUYA, ATSUSHI

Examiner

Hai V. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29, 31-38, 40-47 and 49-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 31-38, 40-47 and 49-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the communication received on 15 November 2006.
2. Claims 30, 39, and 48 were cancelled.
3. Claims 1-29, 31-38, 40-47 and 49-55 are presented for examination.

Response to Arguments

4. Applicant's arguments, see Applicant's remarks, pages 13-16, with respect to the rejection(s) of claim(s) 1-29, 31-38, 40-47 and 49-55 under 35 USC 102(e) and 35 USC 103(a) rejections have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Matsumoto et al. US patent # 6,417,819 B1.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-29, 31-38, 40-47 and 49-55 are rejected under 35 U.S.C. 102(e) as being anticipated by **Matsumoto** et al. US patent # **6,417,819 B1**.
7. As to claim 1, Matsumoto substantially teaches the invention as claimed, including a communication system (*Fig. 1*) including:

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a communication network (*Fig. 1*); and

a plurality of terminal devices (*Figs. 1, 4, users 101, 110 120, 130 210, 310*)

connectable to said communication network for transmitting and receiving an information item (*Fig. 1, a message item, col. 7 line 51 – col. 8, line 9*) through said communication network (*Fig. 5, col. 5, lines 11-18*);

wherein said communication system includes a table (*a table indicating relationships between conditions based on states revealable in the chat system and background images, col. 1, lines 59-60*) which provides at least one retrieval condition and for each said retrieval condition at least one corresponding identifier for an image file to be displayed (*Fig. 7, col. 6, lines 16-29*), so as to enable said terminal devices to detect (*to check (or to evaluate) and to reveal*) in said information item said at least one retrieval condition and if the retrieval condition is detected to display said information item with said at least one corresponding identified image file (*Fig. 12, displaying the chat message with C2, C3; col. 5, lines 11-39; col. 10, lines 5-32; col. 2, lines 1-50*).

8. As to claim 2, Matsumoto teaches wherein each retrieval condition in said table comprises a key object (*Figs. 6, 7, col. 5, line 39 – col. 6, line 55*).

9. As to claim 3, Matsumoto teaches wherein each said key object comprises at least one object selected from the group consisting of key words and key marks (*Figs. 6, 7, col. 5, line 39 – col. 6, line 55*).

10. As to claim 4, Matsumoto teaches wherein said table includes designating data which designate data for displaying said information item with said at least one corresponding identified image file (*Figs. 6, 7, col. 5, line 39 – col. 6, line 55*).

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11. As to claim 5, Matsumoto teaches wherein said table includes necessary data for displaying said information item with said at least one corresponding identified image or sound file (*Figs. 6, 7, col. 5, line 39 – col. 6, line 55*).

12. As to claim 6, Matsumoto teaches wherein said table is editable (*settable, Figs. 6, 7, col. 5, line 39 – col. 6, line 55*).

13. As to claim 7, Matsumoto teaches wherein said table is transferable through said communication network (*Figs. 6, 7, col. 5, line 11 – col. 6, line 55*).

14. As to claim 8, Matsumoto teaches wherein said information item comprises an e-mail (*a chat message*) (*Figs. 6, 7, col. 5, line 11 – col. 6, line 55*).

15. As to claim 9, Matsumoto teaches wherein said e-mail has at least an attached file (*Figs. 6, 7, col. 5, line 11 – col. 6, line 55*).

16. As to claim 10, Matsumoto teaches wherein said table is stored in a memory of said terminal device (*Figs. 6, 7, col. 5, line 11 – col. 6, line 55*).

17. As to claim 11, Matsumoto teaches, wherein said table is open on a server computer on said communication network, so as to enable said terminal device to download said table from said server (*Figs. 6, 7, col. 5, line 11 – col. 6, line 55*).

18. As to claim 12, Matsumoto teaches wherein each of said terminal devices includes:

a first function block (*a condition selecting means, col. 2, lines 24-25*) for performing said retrieval under said retrieval condition with reference to said table (*Figs. 6, 7, col. 1, line 50 – col. 2, line 33; col. 5, line 11 – col. 6, line 55*); and

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a second function block (*a display control means, col. 2, lines 25-30*) for displaying said information item in accordance with said at least one corresponding identified image file (*Figs. 6, 7, col. 1, line 50 – col. 2, line 33; col. 5, line 11 – col. 6, line 55*).

19. As to claim 13, Matsumoto teaches wherein each of said terminal devices further includes:

a third function block (*the functions of the background image display control system are distributed among a plurality of computers connected to the network, col. 2, lines 33-39*) for transmitting and receiving said table through said communication network (*Figs. 6, 7, col. 1, line 50 – col. 2, line 33; col. 5, line 11 – col. 6, line 55*).

20. As to claim 14, Matsumoto teaches wherein each of said terminal devices includes:

a processing unit (*Fig. 4, control unit 30*); and

a memory accessible by said processing unit, and said memory storing a computer program (*Fig. 4, units 70, 90*) comprising the steps of means for performing said retrieval under said at least one retrieval condition with reference to said table (*Fig. 4, the program 91, Fig. 5, the server communication control portion 82*); and

means for displaying said information item in accordance with said at least one corresponding identified image file (*Figs. 4, 5, display unit 20, col. 4, line 46 – col. 5, line 38*).

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21. As to claim 15, Matsumoto teaches transmitting and receiving said table through said communication network (*Figs. 6, 7, col. 1, line 50 – col. 2, line 33; col. 5, line 11 – col. 6, line 55*).

22. Claim 16 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

23. Claims 17-24 introduce identical limitations of claims 2-9; therefore, they are rejected under the same rationale as in claims 2-9.

24. Claims 25-28 introduce identical limitations of claims 12-15; therefore, they are rejected under the same rationale as in claims 12-15.

25. Claim 29 corresponds to the apparatus claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

26. Claims 31-37 introduce identical limitations of claims 2, 4-9; therefore, they are rejected under the same rationale as in claims 2, 4-9.

27. Claim 38 corresponds to the method claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

28. Claims 40-46 introduce identical limitations of claims 2-6, 8-9; therefore, they are rejected under the same rationale as in claims 2-6, 8-9.

29. Claim 47 corresponds to the computer readable medium claim of claim 1; therefore, it is rejected under the same rationale as in claim 1.

30. Claims 49-55 introduce identical limitations of claims 2-6, 8-9; therefore, they are rejected under the same rationale as in claims 2-6, 8-9.

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31. Further references of interest are cited on Form PTO-892, which is an attachment to this action.



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai V. Nguyen whose telephone number is 571-272-3901. The examiner can normally be reached on 6:00-3:30 Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hai V. Nguyen
Examiner
Art Unit 2142



ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER